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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,951	04/20/2001	Liang-Yu Chi	027-0004	1707

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ZAGORIN O'BRIEN & GRAHAM, L.L.P.
7600B N. CAPITAL OF TEXAS HWY.
SUITE 350
AUSTIN, TX 78731

EXAMINER

TRINH, SONNY

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,951

Applicant(s)

CHI, LIANG-YU

Examiner

Sonny TRINH

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-5, 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-13 and 16-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claim 16** recites the limitation "plural visual indications" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-2, 7-8, 11, 13, 17-19, 20-28, 30-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugita ("Sugita" U.S. Patent Number 6,075,778) in view of Makipaa et al. ("Makipaa" U.S. Patent Number 6,556,217).

Regarding **claim 1**, with reference to figures 9-10 and descriptions, Sugita teaches a method of presenting information on a portable device (column 2 lines 1-45), the method comprising:

associating a first indication on the display with a user-defined external state (column 2, specifically lines 10-15);

establishing a user-defined operation for monitoring the user-defined external state (column 2, specifically lines 15-19); and

updating the first indication on the display in accordance with the monitored user-defined external state in response to an information encoding thereof received via a telecommunications network (column 2, specifically lines 1-20).

However, Sugita does not explicitly disclose that the display of the portable device is limited (space constrained). In an analogous art, Makipaa teaches a system and method for content adaptation and pagination based on terminal capabilities. The system calculates the space needed in order to display the information on a user limited terminal screen (column 3, column 4 line 39 through column 6 line 53).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine a method for selecting the amount of information to be display, as taught by Makipaa, with the information selection, as taught by Sugita, in order to obtain only the desired information and display it on the limited (space constrained) on the portable device so as not to cluster the display with useless information that is not particularly interested by the user.

Regarding **claim 2**, Sugita further teaches that the user-defined external state is a weather or environmental state (claim 7).

Regarding **claims 7-8**, Sugita further teaches that the user-defined external state is selected from amongst a predetermined set of external states available for monitoring (column 4 lines 22-43) and obviously selected from amongst a predetermined set of at least partially-predefined queries.

Regarding **claim 11**, Sugita further teaches that the associating of the first indication with the user defined external state and the establishing of the user-defined operation are performed via the portable device (column 4 lines 22-43).

Regarding **claim 13**, Sugita further teaches that the first indication is a graphical indication (column 4 lines 22-43).

Regarding **claim 17**, Makipaa further teaches that the display device includes a two-dimensional array of display elements suitable for simultaneously presenting plural visual indications displaced throughout at least a portion thereof (figure 9, see description).

Regarding **claim 18**, Sugita further teaches that the portable device is a phone (abstract, columns 2-4).

Regarding **claim 19**, Sugita further teaches that the telecommunications network transmission and routing facilities include a wireless voice network (figures 1, 2A, 2B).

Regarding **claims 20-21, 23-24**, these claims merely reflect the apparatus claims as opposed to the method claim of claims 1-2, 19,18 (respectively) and are therefore rejected for the same reasons.

Regarding **claim 22**, Makipaa further teaches that the plural visual indications are grouped based on correspondence of the associated external states (figures 7-9, see descriptions).

Regarding **claim 25**, this claim merely reflects the computer program necessary for performing the steps as specified in claim 1 and is therefore rejected for the same reasons.

Regarding **claims 26-27**, these 2 claims combined merely reflect the computer program necessary for performing the steps as specified in claim 3 and are therefore rejected for the same reasons.

Regarding **claim 28**, Makipaa further teaches the networked information server that accesses one or more data stores in which results of monitoring of the user-defined external states are encoded (figure 1, content server).

Regarding **claim 30**, it is inherent that the computer program product is selected from an electronic storage medium, Makipaa further discloses a network (see figure 1 and description in Makipaa).

Regarding **claims 31-32**, these 2 claims combined merely reflect the means necessary for performing the steps as specified in claim 1 and are therefore rejected for the same reasons.

3. **Claims 6, 9-10, 12, 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugita ("Sugita" U.S. Patent Number 6,075,778), Makipaa et al. ("Makipaa" U.S. Patent Number 6,556,217) and in further view of Harui ("Harui" U.S. Patent Number 6,690,394).

Regarding **claim 6**, the combination of Sugita and Makipaa discloses the invention but does not disclose the step of retrieving from a networked computational service remote from the portable device, an information encoding in correspondence with a result of the performed user-defined operation.

In an analogous art, Harui teaches the method and apparatus for delivering WEB data to a wireless device (abstract). Harui further teaches that a user can specify the amount of information and how often to send that information to a cellular telephone (figures 3-4, see descriptions) which inherently indicates that there is some kind of encoding (user specified amount).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the system of Sugita and Makipaa, the step of using networked computational service remote from the portable device, as taught by Harui, to eliminate the need for having a browser on the portable device to save time and memory by allowing the user to specify the information to be delivered to the wireless device at a computational device such as a computer connected to the internet.

Regarding **claims 9-10**, since Harui teaches that the amount of information to be delivered to the wireless device can be specified, it is obvious that the associating of the first indication with the user-defined external state is performed without use of the portable device and the establishing of the user-defined operation is performed without use of the portable device.

Regarding **claim 12**, Harui further teaches that the user-defined operation includes a query executable at a networked computational service remote from the portable device (figures 1,3-4, see descriptions).

Regarding **claim 29**, this claim merely reflects the computer program necessary for performing the steps as specified in claim 6 and is therefore rejected for the same reasons.

Allowable Subject Matter

4. **Claims 3-5, 14-15** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claim 3**, the prior art of record failed to disclose or fairly suggest the specific combination of structural and functional limitations set forth in claim 3, specifically, wherein the user-defined operation using a networked computational service remote from the portable device and supplying the information encoding in correspondence with a result of the performed user-defined operation.

Regarding **claim 14**, the prior art of record failed to disclose or fairly suggest the specific combination of structural and functional limitations set forth in claim 14, specifically the step of associating a second indication with the user-defined external state, the second indication providing textual description rendered in response to selection, at the portable device, of the first indication.

Regarding **claim 15**, the prior art of record failed to disclose or fairly suggest the specific combination of structural and functional limitations set forth in claim 15, specifically, wherein the display device includes a two-dimensional array of display elements suitable for simultaneously presenting plural visual indications displaced

throughout at least a portion thereof, the first indication corresponding to at least one of the plural visual indications.

Conclusion

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks
Washington, D.C. 20231*

or faxed to:

(703) 872-9306, (for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 6th Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny Trinh whose telephone number is (703) 305-1961. The examiner can normally be reached Monday through Thursdays from 7:00 am to 4:00 p.m., and on alternate Fridays.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Sonny Trinh

Patent Examiner
3/10/04


**SONNYTRINH
PATENT EXAMINER**